

REMARKS

Claims 1-19 are pending in this application. Claims 1-19 stand rejected. By this Amendment, claims 1-5, 10 and 12-16 have been amended. The amendments made to the claims do not alter the scope of these claims, nor have these amendments been made to define over the prior art. Rather, the amendments to the claims have been made to improve the form thereof. In light of the amendments and remarks set forth below, Applicant respectfully submits that each of the pending claims is in immediate condition for allowance.

Applicant submits herewith replacement sheets for Figures 1-7. No new matter has been added.

Applicant includes a copy of the SB08 filed August 4, 2003 and art listing form filed October 12, 2000. Applicant requests consideration and acknowledgement of these cited references.

The Office Action Summary states that some of the certified copies of the priority documents have been received. No list of non-received documents is recited in the Office Action. Applicant submitted certified copies of all the priority documents in this case. Therefore, correction of Applicant's claim to priority is respectfully requested.

Each of independent claims 1, 10, and 12 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,742,352 ("Tsukagoshi") in view of U.S. Patent No. 6,571,220 ("Ogino"). Applicant respectfully requests reconsideration and withdrawal of this rejection.

To establish a *prima facie* case of obviousness, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify a reference or combine references to arrive at the claimed subject matter. The prior art references must also teach or suggest all the limitations of the claim in question. See, M.P.E.P. § 706.02(j). A reference can only be used for what it clearly discloses or suggests. See In re Hummer, 113 U.S.P.Q. 66 (C.C.P.A. 1957); In re Stencel, 4 U.S.P.Q.2d 1071, 1073 (Fed. Cir. 1987). Here, the references, whether taken individually or in combination, do not disclose or suggest the invention claimed by the Applicant.

Independent apparatus claims 1 and 12 require “a synchronizer for synchronizing the recovered text data stream to the recovered digital video stream in response to the detection of said digital watermark.” Independent method claim 10 recites “detecting the digital watermark embedded in the recovered digital video stream and using the digital watermark as a timing signal for reading the text data from said storage medium.” The prior art references in the Office Action fail to disclose Applicant’s system and method for synchronizing text data streams to video streams using digital watermark information. In fact, according to Applicant’s explicitly recited claim limitations, a digital watermark in the received video screen is used as a timing signal for synchronizing text data to associated video streams.

Applicant explicitly claims a synchronizer for synchronizing ... in response to the detection of said digital watermark. This feature of Applicant’s invention is not shown in either the Tsukagoshi or the Ogino references. The Office Action asserts that Applicant’s explicitly claimed synchronizer is disclosed in Tsukagoshi at

column 13, lines 34-48. Applicant respectfully asserts that the synchronizer disclosed in Tsukagoshi is not a synchronizer for synchronizing in response to the digital watermark. The synchronizer disclosed in Tsukagoshi is a standard synchronizing circuit that synchronizes with the timing of the horizontal sync signal (H sync) or vertical sync signal (V sync) are output from a clock generator. Further, in Ogino, the watermark is not used for synchronization of the video stream and the text data stream. The watermark in Ogino is used for copy control. As such, neither of the cited references disclose the synchronizer explicitly recited in Applicant's claims.

The Office Action asserts that Tsukagoshi could have been modified by Ogino to arrive at the claimed invention. Office Action at 3. The Office Action goes on to state that “[F]urthermore, the synchronizing of the text and video streams could be in response to the detection of a digital watermark in the video stream.” Office Action at 4. The Office Action finally asserts that one of ordinary skill in the art would have been motivated to make the above system at the time of the claimed invention, because using digital watermarks deters piracy and helps to protect owner's rights to digital material.

To properly reject the Applicant's claims for obviousness in view of a combination of prior art references, the Office Action must establish that a person of ordinary skill in the art would have been motivated to combine the cited references and, in combining them, would have arrived at the invention claimed by the Applicant. In re Kotzab, 208 F.3d 1365, 1370 (Fed. Cir. 2000). A motivation to combine may arise from: (i) either explicit or implicit statements in the prior art

references themselves; (ii) the knowledge of those of ordinary skill in the art that certain references, or disclosures in those references, are of special interest or importance in the field; or (iii) the nature of the problem to be solved. Ruiz v. A.B. Chance Co., 234 F.3d 654, 665 (Fed. Cir. 2000).

Regardless of its source, or the form that it takes, a motivation to combine must be clearly and particularly shown. In re Dembiczak, 175 F.3d 994, 999-1000 (Fed. Cir. 1999). The Federal Circuit has held that a motivation to combine is not shown by the mere assertion that the claimed invention would have been obvious to one of ordinary skill in the art simply because it is a combination of elements that were known at the time of the invention:

[T]here is no basis for concluding that an invention would have been obvious solely because it is a combination of elements that were known in the art at the time of the invention. See Fromson v. Advance Offset Plate, Inc., 755 F.2d 1549, 1556, 225 USPQ 26, 31 (Fed.Cir.1985). Instead, the relevant inquiry is whether there is a reason, suggestion, or motivation in the prior art that would lead one of ordinary skill in the art to combine the references, and that would also suggest a reasonable likelihood of success. See, e.g., In re Dow Chem. Co., 837 F.2d 469, 473, 5 USPQ2d 1529, 1531-32 (Fed.Cir.1988).

Smiths Indus. Medical Systems Inc. v. Vital Signs, Inc., 183 F.3d 1347, 1356 (Fed. Cir. 1999); see also, In re Dembiczak, 175 F.3d at 999-1000 (Fed. Cir. 1999).

The Office Action fails to present a reference in which the synchronization of the text and video streams are in response to the detection of a digital watermark in the video stream. The mere assertion that the synchronization of the text and video streams could be in response to the detection of a digital watermark in the video stream does not even rise to the level of the assertion made and rejected by the Federal Circuit in Smith. The Office Action merely asserts that the synchronization could be done, however, no reference is provided in which the synchronization is done in response to the digital watermark. Further, as set forth in the method claim, no reference is provided in which a detected watermark is used as a timing signal for reading text data from a storage medium. As such, the Office Action fails to set forth the explicitly recited limitations in Applicant's claims.

The Office Action has failed to meet this requirement as none of the references set forth the synchronizer for synchronizing in response to the detection of said digital watermark. Further, none of the references suggest this modification.

The Office Action may be attempting to take Official Notice that the synchronizing of the text and video streams could be done in response to the detection of a digital watermark in the video stream. However, the issue of whether synchronization could be done in response to the detection of a digital watermark is exactly the type of thing that Official Notice may not be relied upon for. See, M.P.E.P. § 2144.3A (“[W]e reject the notion that judicial or administrative notice may be taken of the state of the art. The facts constituting the state of the art are normally subject to the possibility of rational disagreement among reasonable men

and *are not amenable to the taking of such notice.*” Citing In re Eynde, 480 F2d 1364, 1370 (C.C.P.A. 1973) (emphasis supplied).

In view of the fact that M.P.E.P. specifically states that Official Notice may not be used with regard to the state of the art, the Examiner is requested in the next Office Action to provide evidence that “the synchronizing of text and video streams could be in response to the detection of digital watermark in a video stream.” Of course, such evidence should have been provided in the first place to support a finding of obviousness.

Claims 2-9 depend either directly or indirectly from, and contain all the limitations of claim 1. These dependent claims also recite additional limitations which, in combination with the limitations of claim 1, are neither disclosed nor suggested by Tsukagoshi and are also believed to be directed towards the patentable subject matter. Thus, claims 2-9 should also be allowed.

Claim 11 depends from, and contain all the limitations of claim 10. This dependent claim also recites additional limitations which, in combination with the limitations of claim 10, are neither disclosed nor suggested by Tsukagoshi and are also believed to be directed towards the patentable subject matter. Thus, claim 11 should also be allowed.

Claims 13-19 depend either directly or indirectly from, and contain all the limitations of claim 12. These dependent claims also recite additional limitations which, in combination with the limitations of claim 12, are neither disclosed nor

suggested by Tsukagoshi and are also believed to be directed towards the patentable subject matter. Thus, claims 2-9 should also be allowed.

Applicant has responded to all of the rejections and objections recited in the Office Action. Reconsideration and a Notice of Allowance for all of the pending claims are therefore respectfully requested.

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of the claims and to pass this application to issue.

If the Examiner believes an interview would be of assistance, the Examiner is welcome to contact the undersigned at the number listed below.

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Respectfully submitted,

By 

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